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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/326,106	06/04/1999	GULILAT GEBEYEHU	45-93A	3765

23713 7590 10/01/2002

GREENLEE WINNER AND SULLIVAN P C  
5370 MANHATTAN CIRCLE  
SUITE 201  
BOULDER, CO 80303

EXAMINER

MARSCHER, ARDIN H

ART UNIT PAPER NUMBER

1631

DATE MAILED: 10/01/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/326,106

Applicant(s)  
Gebeyehu et al.

Examiner  
Ardin Marschel

Art Unit  
1631



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jun 21, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 12-30, 34, 35, and 67-104 is/are pending in the application.
- 4a) Of the above, claim(s) 23-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-22, 34, 35, and 67-104 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 12-30, 34, 35, and 67-104 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some\* c) ☐ None of:

- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.

- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

Applicants' arguments, filed 6/21/02, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

Claims 12-22, 34, 35, and 67-104 are rejected, as discussed below, under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

This rejection is reiterated and maintained from the previous office action, mailed 3/12/02, and as necessitated by amendment regarding newly added claim 104. Applicants argue that open bonds are well known in the art as to what they intend to depict. In response this is an allegation without factual support and thus non-persuasive. Additionally, applicants argue that the structures are polymers. In response, even polymers are terminated by end groups which are undefined as instantly claimed and thus still vague and indefinite. Applicants further argue that polysaccharides are well known to have hydroxy termini. In response applicants are queried as to why N-acetyl terminated polysaccharides, just to choose an example, do not have hydroxy termini but rather at least one N-acetyl terminus. Thus, it is

confusing as to what well known art recognition requires polysaccharides to be hydroxy terminated.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 12, 13, 21, 34, and 104 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by the Histidine-Lysine containing peptide of Wood et al. (1985).

Apparently, in the previous office action, mailed 3/12/02, a Sigma Catalog was incorrectly inadvertently cited. The Wood et al. reference, copy enclosed, is prior art and discloses the peptide described below.

In instant claim 12, one option is a compound of Z = a basic amino acid, such as lysine, with R being an alkyl group resulting in a modified terminal lysine wherein a methyl group ( $m = 1$ ) replaces a terminal hydrogen at the carboxy terminal as in the Wood et al. peptide disclosed in the first two lines of the abstract on page 797. The other component (Z) of the instant compound of claim 12, for example, may be a basic amino acid, such as histidine, without a methyl or alkyl moiety attached.

Histidine (thus  $m = 0$ ) for this Histidine amino acid as required in instant claim 12. This makes up the instant claim limitations of the depicted peptide as claimed with  $n = 2$  in instant claim 12. It is noted that other moieties, without limitation, may then be present in the peptide of the claims due to the unclear open bonds in the depicted structure as discussed above as being vague and indefinite. It is noted that one possible interpretation of the instant claims is such a compound as noted, albeit with unclarity, in the above rejection under 35 U.S.C. § 112, second paragraph. Claim 34 is included here due to the kit contents being only one compound of claim 12 in its simplest form.

No claim is allowed.

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703)308-4242 or (703)305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (703)308-3894. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (703)308-4028.

Any inquiry of a general nature or relating to the status of this application should be directed to Patent Analyst, Tina

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Plunkett, whose telephone number is (703)305-3524 or to the  
Technical Center receptionist whose telephone number is (703)  
308-0196.

September 30, 2002

*Ardin H. Marschel*  
ARDIN H. MARSCHEL  
PRIMARY EXAMINER